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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/018,649 | 03/25/2002 | Friedrich Boecking | 1928 | 1943 |

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Striker Striker & Stenby
103 East Neck Road
Huntington, NY 11743

EXAMINER

DOUGHERTY, THOMAS M

ART UNIT

PAPER NUMBER

2834

DATE MAILED: 11/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|--|---------------------------------|---|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/018,649 | BOECKING, FRIEDICH <i>u</i> | |
| | Examiner Thomas M. Dougherty | Art Unit 2834 | |
| <i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i> | | | |
| Period for Reply | | | |
| A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION. | | | |
| <ul style="list-style-type: none"> - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). | | | |
| Status | | | |
| 1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>25 March 2002</u> . | | | |
| 2a) <input type="checkbox"/> This action is FINAL. | | 2b) <input checked="" type="checkbox"/> This action is non-final. | |
| 3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213. | | | |
| Disposition of Claims | | | |
| 4) <input checked="" type="checkbox"/> Claim(s) <u>1-9</u> is/are pending in the application. | | | |
| 4a) Of the above claim(s) _____ is/are withdrawn from consideration. | | | |
| 5) <input type="checkbox"/> Claim(s) _____ is/are allowed. | | | |
| 6) <input checked="" type="checkbox"/> Claim(s) <u>1,7 and 8</u> is/are rejected. | | | |
| 7) <input checked="" type="checkbox"/> Claim(s) <u>2-6 and 9</u> is/are objected to. | | | |
| 8) <input type="checkbox"/> Claim(s) _____ are subject to restriction and/or election requirement. | | | |
| Application Papers | | | |
| 9) <input type="checkbox"/> The specification is objected to by the Examiner. | | | |
| 10) <input checked="" type="checkbox"/> The drawing(s) filed on <u>25 March 2002</u> is/are: a) <input checked="" type="checkbox"/> accepted or b) <input type="checkbox"/> objected to by the Examiner. | | | |
| Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). | | | |
| 11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a) <input type="checkbox"/> approved b) <input type="checkbox"/> disapproved by the Examiner. | | | |
| If approved, corrected drawings are required in reply to this Office action. | | | |
| 12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner. | | | |
| Priority under 35 U.S.C. §§ 119 and 120 | | | |
| 13) <input checked="" type="checkbox"/> Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). | | | |
| a) <input checked="" type="checkbox"/> All b) <input type="checkbox"/> Some * c) <input type="checkbox"/> None of: | | | |
| 1. <input checked="" type="checkbox"/> Certified copies of the priority documents have been received. | | | |
| 2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____. | | | |
| 3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). | | | |
| * See the attached detailed Office action for a list of the certified copies not received. | | | |
| 14) <input type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application). | | | |
| a) <input type="checkbox"/> The translation of the foreign language provisional application has been received. | | | |
| 15) <input type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121. | | | |
| Attachment(s) | | | |
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. | |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) | |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | | 6) <input type="checkbox"/> Other: _____. | |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. No proper antecedent basis has been found for citation of "the pretensioning spring".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Igashira (US 4,550,744). Igashira shows (fig. 1) a piezoelectric actuator having a piezoelectric element (148) for actuating a mechanical component with a pulling or pushing force, and a compensating element (146), wherein the piezoelectric element (148) and the compensating element (146) are mechanically coupled to the piezoelectric element (148) in such a fashion that the temperature-induced expansions of the piezoelectric element (148) and the compensating member (146) cancel each other out in the effective direction in such a fashion that the actuating element remains in its position. See claim 1 paragraph (g). The piezoelectric element (148) is composed of a

multilayer structure of transversely arranged, ceramic piezoelectric plies that become longer in the effective direction when an external electric voltage is applied, and the compensating element (146) is made of ceramic. See col. 2, ll. 62-65.

Allowable Subject Matter

Claim 2-6 and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The prior art fails to show a heat transfer compound located between the piezoelectric element and the compensating element. The prior art fails to show a support plate which is fixed on one end and a fixed support plate on the other end of the piezoelectric actuator element further comprising a spring on each end in a structure including a temperature compensating element. The prior art fails to show a temperature compensating element made of ceramic plies.

Conclusion

Claim 7 is so indefinite that art cannot be applied against it at this time. When it is made definite a consideration of its relationship to the prior art will be made.

The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. Sullivan et al. (US 6,313,568) reads on at least claim 1 of the Applicants' invention however his priority date is after that of the Applicants.

Direct inquiry concerning this action to Examiner Dougherty at (703) 308-1628.

Application/Control Number: 10/018,649
Art Unit: 2834

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September 24, 2002

Thomas M. Dougherty

THOMAS M. DOUGHERTY
PRIMARY EXAMINER
GROUP 2100
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